

REMARKS

Claims 1-53 are pending. A restriction requirement has been maintained in the instant Office Action for two groupings of the pending claims, i.e., Group I - Claims 1-45, and Group II - Claims 46-53. Although the restriction of the pending claims into these two groupings has been argued against with traverse, the present Office Action has found the reasoning non-persuasive and the restriction requirement has been upheld. In response, Group I (Claims 1-45) is elected for further examination and Group II (Claims 46-53) is withdrawn from consideration at this time.

Rejection under 35 USC 103

The Office Action has rejected Claims 1-7, 9-11, 13, 14, 17-22, 26-31, 33-35, 37, 38, 41, and 42 under 35 USC 103(a) as being unpatentable over U.S. Patent No. 6,012,051, invented by Sammon, et al. (hereinafter Sammon) in view of U.S. Patent No. 5,78,142, invented by Jacobs (hereinafter Jacobs).

In regard to Claim 1 and 26, the Office Action noted that Sammon disclosed a method and system that allegedly taught roughly half of the features of the claimed invention. The Office Action also interpreted the Sammon term "product domain" to include categories of products in a manner that is neither taught nor suggested by the reference. Additionally, the Office Action admitted that since Sammon failed to disclose many of the claimed features, another reference (Jacobs) must be relied upon in combination with Sammon to allegedly teach these missing features. Moreover, the Office Action found Claims 1 and 26 obvious in view of the suggested combination of Sammon and Jacobs. This finding of obviousness is unsustainable for at least the reasons that follow.

First, the Office Action has improperly interpreted the meaning of Sammon's "product domain" to encompass substantially the same meaning as the claimed "commodity categories" term. Throughout the Sammon reference, the term "product domain" is clearly used to refer to a single specific type of product (commodity), such as a car or bank account that is ranked based on consumer preferences. It is notable that Sammon does not teach or suggest that "motorized

vehicles” or generic “financial services” are a product domain. Rather, various providers of a particular type of product such as a car are ranked based on customer preferences. (Column 5, lines 14-23).

In contrast, the claimed invention teaches combinations of commodity categories (multiple products) that are ranked, e.g., local phone service, regional toll service, long distance, and calling card plans. (Page 31, table 4). At least because nowhere in the Sammon reference is there a teaching or suggestion that combinations of multiple products (commodities) with different options can be ranked, the Office Action’s interpretation of Sammon’s “product domain” to include such a meaning that makes a portion of the claimed invention obvious is not sustainable.

Second, the Office Action has admitted that Sammon does not teach choosing options for commodity categories and other related features. Instead the Office Action has relied upon Jacobs to back fill the missing disclosure. However, nowhere in Jacobs is there a teaching for selecting options for multiple categories of commodities (products) that can be ranked. Instead, the cited reference discloses enabling a consumer to select *designs* for a particular type of product, i.e., greeting cards, not options for categories of products (commodities). Therefore, since Jacobs does not disclose or suggest what the Office Action has alleged, this reference can not be used either singly or in combination to find the claimed invention obvious.

Additionally, a person of ordinary skill in the art would not be inclined to combine an invention to select designs for greeting cards at a kiosk with an invention directed to ranking a particular type of product based on a customer’s preferences. Further, absent some teaching, suggestion, or clue in either reference to combine their teachings, the Office Action can not combine these disparate references to find the claimed invention obvious. Therefore, for at least the reasons cited above, Claims 1-7, 9-11, 13, 14, 17-22, 26-31, 33-35, 37, 38, 41, and 42 are non-obvious and allowable over the cited references of Sammon and Jacobs.

Additionally, the Office Action has rejected Claims 8 and 32 under 35 USC 103(a) as being unpatentable over Sammon in view of Jacobs and further in view of U.S. Patent No. Kimura

et al. (hereinafter Kimura). Also, the Office Action has rejected Claims 12, 15, 16, 36, 39 and 40 32 under 35 USC 103(a) as being unpatentable over Sammon in view of Jacobs and further in view of U.S. Patent No. 6,085,165 Ulwick (hereinafter Ulwick). Additionally, the Office Action has rejected Claims 23-25 and 43-45 under 35 USC 103(a) as being unpatentable over Sammon in view of Jacobs and further in view of U.S. Patent No. 6,292,787 Scott et al. (hereinafter Scott). However, for at least the same reasons as discussed above, none of the suggested combinations of references make the claimed invention obvious and all of the pending claims are allowable.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Dated: September 3, 2003

Respectfully submitted,

By 

John W. Branch

Registration No.: 41,633

DARBY & DARBY P.C.

P.O. Box 5257

New York, New York 10150-5257

(206) 262-8906

(206) 262-8901 (Fax)

Attorneys/Agents For Applicant

Customer No.: 07278